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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,680	02/13/2004	Nobuyuki Eto	Q79867	5870
23373 7590 11/24/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER LAZORCIC, JASON L				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/777,680

Applicant(s)

ETO ET AL.

Examiner

JASON L. LAZORCIK

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

Applicants reply dated July 13, 2009 amends claim 1 and cancels claims 2 and 8. All other claims stand as previously presented in Applicants reply dated February 17, 2009.

Claims 1, 3-4, and 6-7 are pending in the Application, and no claims have been withdrawn from consideration. Therefore, Claims 1, 3-4, and 6-7 are pending for prosecution on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Aratani (US 4,671,814).

Aratani teaches a method for strengthening a glass substrate having a thickness of about 1.0mm by chemical strengthening. As set forth in Example 1 (Column 8, Lines 39-53), the immediate reference teaches that,

"The sample disks were immersed in a bath of molten sodium nitrate...The sample disks taken up from the bath were left to cool down and were washed with water to remove adherent sodium nitrate and dried.

After the above treatment with sodium nitrate, all the sample disks were immersed in a bath of molten potassium nitrate....The samples taken up from the molten potassium were left to cool down, washed and dried."

The Aratani disclosure clearly sets forth a two step process wherein a glass substrate is process with a first alkali ion of a first molten salt containing only sodium nitrate and followed with a subsequent treatment using a second alkali ion of a second molten salt containing potassium nitrate. Applicant is advised that the claimed effect upon compressive stress at the surface of the substrate and tensile stress at an interior depth of the substrate are understood implicitly to follow from the disclosed process (see discussion pages 5-6, Official Action dated April 13, 2009).

It is further noted that the prior art reference teaches ranges for the first and second step process times and temperatures (col. 6, lines 37-68) which overlap Applicants preferred conditions (see Specification ¶¶[0070-0073]). Again, absent compelling evidence to the contrary, the recited effect upon compressive and tensile stresses in the glass substrate are construed to follow naturally from the Aratani disclosed process.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aratani (US 4,671,814) in view of Takahashi (US 6,119,483).

As noted above in the rejection of claim 1 under 35 USC §102(b), Aratani teaches a method for chemically strengthening a glass substrate by a two stage process including a first treatment in a molten salt bath comprising only sodium nitrate and a subsequent immersion in molten potassium nitrate.

(I) Aratani is silent regarding the composition of the glass substrate as recited in Claim 3.

Regarding the composition of the glass substrate, Aratani states that the chemical composition of the glass for use in the present invention "is not particularly limited and may belong to soda-lime-silicate glass, boro-silicate glass or alumino-silicate glass, or to a still different type of glass" (Col. 5, lines 27-32). Aratani later explicitly

teaches that it is preferable to utilize "a lithium salt when the principal alkali metal in the glass composition is lithium" and that "it is also possible to use a mixture of a sodium salt or sodium salts and a lithium salt or lithium salts". It follows that although Aratani is silent regarding the particular lithium-aluminosilicate glass as recited in Applicants claimed invention, such compositions of glass have been expressly considered by the inventors for use in the Aratani disclosed process.

(II) Applicants recited glass composition would have been obvious in view of the Takahashi disclosed process.

The reference to Takahashi discloses a closely related method for chemically strengthening a glass substrate by immersion in molten sodium and potassium nitrate salts wherein said strengthened substrate may be employed for use as a magnetic disk substrate.

With respect to **claim 3**, the Takahashi reference teaches that an aluminosilicate glass to be used for chemical reinforcement contains as principle components 57 to 74% SiO₂, 3 to 15% of Al₂O₃, 7 to 16% of Li₂O and 4 to 14% of Na₂O, each in terms of mole percent (Column 9, Lines 25-31). The reference continues with a preferred example of ~67% SiO₂, ~1% ZnO₂, ~9%Al₂O₃, ~12%Li₂O and ~10%Na₂O, each in terms of mole %. The cited example composition for the aluminosilicate glass reads directly upon the claimed concentration ranges for each constituent.

Since Aratani explicitly discloses that the disclosed process may be used with lithium aluminosilicate glasses, one of ordinary skill in the art would have found it merely obvious to employ the Takahashi disclosed glass composition in the chemical strengthening process according to Aratani.

Regarding **Claim 6**, Takahashi indicates that “the magnetic disk is produced by forming a thin film such as a magnetic layer on a substrate and as the substrate for it,...(a) glass substrate has been employed” (Column 1, Lines 21-23)

Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aratani (US 4,671,814) and Takahashi (US 6,119,483) and as applied above and in further view of Morehouse (US 5,379,171).

(III) The prior art is silent regarding the use of glass sheets having a thickness in the range as recited in claims 4 and 7

As set forth above, the collective prior art references teach every element of the Applicants parent claim 1. Specifically, Takahashi teaches that it is known to subject glass substrates of the claimed composition to a chemical strengthening operation when preparing a magnetic hard drive substrate. Aratani teaches that it is known to use Applicants claimed sequential, two-stage salt bath technique when chemically

tempering a glass substrate in order to minimize deformation of the substrate.

Takahashi teaches a specific embodiment wherein the glass disks have a thickness of 1.5 mm, and Aratani teaches substrates having a thickness of "about 1.0mm".

As indicated in previous Office Actions dated November 1, 2007 and August 21, 2007, it is the Examiners position, in light of the Takahashi and Aratani disclosures, that the use of a substrate with a thickness of "0.2 to 0.9mm" or "0.2 to 0.6mm" represents a merely an obvious extension over the prior art of record. Specifically, Takahashi teaches the use of glass substrates having a thickness nearly equivalent to Applicants claimed thickness and Aratani teaches that the chemical tempering operation is applicable to substrates having a thickness of "about 1.0mm" thick. One having no more than an ordinary level of skill would have reasonably construed glass sheets of 0.9 or 0.6mm thickness as "about" 1.0mm or at least have found it obvious to try glass sheets of such a thickness.

This point notwithstanding, neither of the cited references explicitly teaches the use of a glass substrate within the claimed thickness ranges.

(IV) Use of Applicants recited glass sheet thickness would have been obvious in view of the United States patent to Morehouse

The United States patent to Morehouse et. al. teaches the detailed construction of a magnetic hard drive device. With respect to the disk substrate, Morehouse teaches that (Column 43, lines 35-47);

"Magnetic recording disk 10 comprises a thin film surface, with coercivity greater than 1500 Oe, coated with materials such as Co--Ni or Co--Cr--Ta alloys, applied to both sides of a rigid substrate by methods such as RF sputtering or plating. The substrate used with magnetic recording disk 10 is preferably about 0.445 mm thick, with very flat, smooth, surfaces and with good mechanical rigidity. Examples of suitable substrate materials are aluminum alloys, glass and ceramic materials." (emphasis added)

As evidenced by the Morehouse reference, the use of a glass substrate having a thickness of 0.445mm which is in the range of 0.2 to 0.9 mm [Claim 4], or alternately from 0.2 to 0.6mm thick [Claim 7], is known in the art of hard drive manufacture. In view of the instant disclosure, the use of a substrate of the claimed thickness would be considered obvious to one of ordinary skill in the art at the time of the invention.

Response to Arguments

Applicant's arguments with respect to claims 1,3-4, and 6-7 dated July 13, 2009 have been considered but are moot in view of the new ground(s) of rejection.

Further, to the extent that Applicant insinuates that the Aratani first stage (using sodium ions) is intended to improve the warp characteristics of the glass substrate and not to chemically strengthen the glass substrate, it is noted that the Aratani reference teaches operating conditions for the first and second step process times and temperatures (col. 6, lines 37-68) which overlap Applicants preferred conditions (see Specification ¶[0070-0073]). In addition, Applicant has been previously advised that the claimed effect upon compressive stress at the surface of the substrate and tensile stress at an interior depth of the substrate are understood implicitly to follow from the disclosed process (see discussion pages 5-6, Official Action dated April 13, 2009). Therefore, absent compelling evidence to the contrary, the recited effect upon compressive and tensile stresses in the glass substrate are construed to follow naturally and inherently from the Aratani disclosed process.

Stated alternately, since Aratani teaches materials and methods which substantially overlap Applicants most preferred conditions, it would appear evident that the prior art process will result in substantially the same outcome, including *inter alia*, the recited effects upon the compressive and tensile stresses manifest in the glass substrate. The fact that Applicant has explicitly recited a physical property which otherwise inherently flows from the prior art process, namely that the first stage process strengthens the glass substrate, is insufficient to patentably distinguish the claimed invention over that disclosed in the Aratani reference.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JASON L. LAZORCIK** whose telephone number is (571)272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason L Lazorcik/
Primary Examiner, Art Unit 1791